

**REMARKS**

Claims 2, 4, 7 and 10 have been previously canceled and Claims 20 - 24 have been previously withdrawn. By this amendment, Claims 1, 5, and 15 have been amended and Claims 3 and 8 have been canceled. Therefore, Claims 1, 5-6, 9, and 11-19 are pending in this application.

Claims 1, 3, 5, 6, 8, 9, and 11-14 were objected to for being unclear "as to where the microdevice/nanodevice is introduced and how the step of introducing is related to the step of inserting." The Office Action, page 2, paragraph 2. Accordingly, Applicant has amended Claims 1, 5, and 15.

Claim 15 was rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825).

Claim 16 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Schecter *et al.*, U.S. Pat. 4,120,649 (US '649).

Claims 17-19 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Dustin *et al.*, U.S. Pat. 5,071,964 (US '964) or Li *et al.*, U.S. Pat. 6,090,408 (US '408).

Claims 1,3, 5-6, 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.* (US '825) in view of Berg *et al.*

Claims 11, 12 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.* (US '825) in view of Berg *et al.* as applied to claim 1 above, and further in view of Ostensen *et al.*

Claim 13 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Ostensen *et al.*, as applied to claim 12 above, and further in view of Chandrakumar *et al.*, U.S. Pat. 6,472,874 (US '874).

Applicants respectfully traverse the claim objections, the §102(b) rejections, and §103(a) rejections with the following arguments.

**35 U.S.C. §102(b)**

The Examiner rejected claim 15 under 35 U.S.C. 102(b) as allegedly being anticipated by Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825).

Applicants respectfully traverse the Examiner's rejection of claim 15, because US '825 does not teach each and every feature of Applicants' claim 15. For example: the US '825 reference does not teach "encapsulating at least one of said microdevice and said nanodevice with non immunogenic polymers, wherein the at least one of said microdevice and said nanodevice is extracellular (emphasis added);" as in Applicants' claim 15. Applicants submit that instead, US '825 teaches "coating with an antibody," which is not a non immunogenic polymer. See US '825 Abstract.

In light of the foregoing, Applicants respectfully submit that claim 15 is in condition for allowance because Benjamin *et al.* does not teach "encapsulating at least one of said microdevice and said nanodevice with non immunogenic polymers (emphasis added)," as in Applicants' claim 15.

**35 U.S.C. §103(a)**

Claim 16 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Schechter *et al.*, U.S. Pat. 4,120,649

(US '649). Claims 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Dustin *et al.*, U.S. Pat. 5,071,964 (US '964) or Li *et al.*, U.S. Pat. 6,090,408 (US '408). Applicants traverse the Examiner's rejections of claim 16 as allegedly unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Schechter *et al.*, U.S. Pat. 4,120,649 (US '649) and the Examiner's rejection of Claims 17-19 under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Dustin *et al.*, U.S. Pat. 5,071,964 (US '964) or Li *et al.*, U.S. Pat. 6,090,408 (US '408) because the Examiner's cited prior art does not teach or suggest "encapsulating at least one of said microdevice and said nanodevice with non immunogenic polymers (emphasis added)," as in Applicants' claim 15.

In light of the foregoing, Applicants respectfully submit that claims 16-19 are in condition for allowance because the Examiner's cited prior art does not teach or suggest encapsulating the microdevice and said nanodevice with non immunogenic polymers.

Claims 1, 3, 5-6, 8, 9, and 14 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Berg *et al.* Applicants respectfully traverse the Examiner's rejection because there is no motivation to combine US '825 Benjamin *et al.*, U.S. Pat. 4,793,825 (US '825) in view of Berg *et al.*

As the Examiner's primary reference Benjamin US '825 teaches *inter alia* encapsulating a device by a white cell. See US '825, column 15, lines 33-34. In addition, US '825 only teaches introducing a device into a cell by encapsulation. See Benjamin *et al.* generally. In order to support an obviousness type rejection of claim 1, the Examiner must state where the cited prior art teaches or suggests a motivation to modify a primary reference, here, Benjamin *et al.* US '825, by

a secondary reference, here Berg *et al.* However the Examiner does not so state the motivation to combine the cited prior art nor does US '825 or Berg *et al.* teach or suggest a motivation to look to Berg, *et al.* to either encapsulate a device by any other cell than a white cell or to look to Berg *et al.* for introducing a device by encapsulation because Berg *et al.* only teaches "introducing molecules into the cytosol of living cells using means other than encapsulation." Berg *et al.*, column 1, lines 8-20. Applicants respectfully submit that a person skilled in the art would not look to Berg *et al.* to practice the encapsulating method of US '825. Therefore, Applicants contend the Examiner has failed to meet his burden of proof to satisfy the rejection of claim 1 under 35 U.S.C. §103(a) and therefore should withdraw the rejection.

In summary, Applicant submits that independent claim 1 and claims 5-6, 9, and 14, depending from claim 1 are in condition for allowance because the Examiner's rejection lacks motivation to combine the cited prior art because neither Benjamin *et al.*, (US '825) nor Berg *et al.* teach or suggest either encapsulating a device with a white cell or introducing a device into a cell by encapsulation, as does Benjamin (US '825).

Applicants respectfully submit that the Examiner's rejections of claims 11-13 which depend from independent claim 1, under 35 U.S.C. §103(a) over Benjamin *et al.* in combination with the Examiner's other cited prior art fail for the same reason that Applicants used to overcome the Examiner's rejection of claim 1, *supra*.

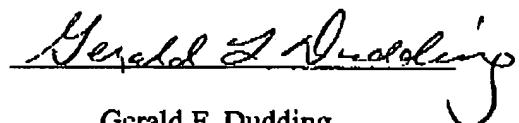
In light of the foregoing, Applicants respectfully submit that claims 1, 5-6, 9, and 11-19 are in condition for allowance under 35 U.S.C. §103(a) over Benjamin *et al.*, either alone or in combination with the Examiner's other cited prior art because 1) there is no motivation to combine Benjamin *et al.* (US '825) and Berg *et al.* as to claims 1 and claims 5-6, 9, and 11-14,

and 2) claims 16-19 are in condition for allowance because the Examiner's cited prior art does not teach or suggest encapsulating the microdevice and said nanodevice with non immunogenic polymers.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 19-0513.

Date: June 20, 2005



Gerald F. Dudding  
Registration No. 52835

Schmeiser, Olsen & Watts  
3 Lear Jet Lane, Suite 201  
Latham, New York 12110  
(518) 220-1850